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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,753	04/21/2006	Junichi Kobayashi	Q94259	6071
23373	7590	11/29/2007		
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER DAVIS, BRIAN J	
			ART UNIT 1621	PAPER NUMBER
			MAIL DATE 11/29/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/576,753

Applicant(s)

KOBAYASHI ET AL.

Examiner

Brian J. Davis

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-12 is/are allowed.
- 6) ☒ Claim(s) 14, 16 and 17 is/are rejected.
- 7) ☒ Claim(s) 13-17 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/12/06;4/21/06</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: the parentage of the application should be included in the first line of the specification immediately after the title. See MPEP 1893.03(c). Appropriate correction is required.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

Claims 13-17 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The compositions, agents, combinations, uses and methods of claims 13-17 do not and cannot further limit the *compounds* of claim 1.

Claim Rejections - 35 USC § 112, FIRST PARAGRAPH

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 14, 16 and 17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a therapeutic agent and a method of treatment, does not reasonably provide enablement for a prophylactic agent or a method of preventing obesity, diabetes, etc. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

With regard to rejections under 35 USC 112, first paragraph, the following factors are considered (*In re Wands* 8 USPQ 2d 1400, 1404 (CAFC 1988)): a) Breadth of claims; b) Nature of invention; c) State of the prior art; d) Level of ordinary skill in the art; e) Level of predictability in the art; f) Amount of direction and guidance provided by the inventor; g) Working examples and; h) Level of experimentation needed to make or use the invention based on the content of the disclosure.

a)The claims are quite broad: a prophylactic agent or a method of preventing obesity, diabetes, etc. Prophylaxis is commonly defined as prevention. (See, for instance, *The American Heritage Dictionary of the English Language 4th ed.*, (2000), page 1406.)

b,c)The nature of the invention is determined in part by the state of the prior art.

Even a cursory perusal of the teachings of the medicinal arts reveals that they have not advanced to the point where complex conditions such as diabetes can be said to be preventable.

d)The level of skill in the art is considered to be relatively high.

e)The level of predictability in the art is considered to be relatively low.

The basis of all modern medicine and biology is, of course, chemistry. Yet even under the best of circumstances, and several hundred years after Lavoisier laid the foundations of its modern practice, chemistry remains an experimental science. Neither the medicinal/biological arts nor the chemical arts upon which they are based have advanced to the point where certainty has replaced the need for clinical and/or laboratory experimentation.

f,g)The amount of direction provided by the inventor is considered to be determined by the specification and the working examples. Applicant's data do not demonstrate that the instant compounds prevent obesity, diabetes, etc.

h)Regardless of the amount of experimentation involved, applicant's claims to the prevention of the listed diseases are not believable in light of present understanding in the contemporary medicinal arts. It is settled case law that allegations of utility that are not believable in light of the contemporary knowledge in the art must be substantiated by acceptable evidence or stricken from the specification. In re Ferns, 163 USPQ 609 (CCPA 1969; Ex Parte Moore, 128, USPQ 8 (BPAI 1960); In re Hozumi, 226, USPQ 353 (Comr. Dec. 1985); MPEP 706.03(n) and 706.03(z).

Claim Rejections - 35 USC § 112, SECOND PARAGRAPH

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 16 provides for the *use* of a compound, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 16 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Allowable Subject Matter

Claims 1-12 are allowed. The following is a statement of reasons for the indication of allowable subject matter:

The closest prior art appears to be WO 99/65877, cited by applicant in the IDS, which teaches a set of structurally related compounds to those of the instant invention. The cited prior art neither teaches nor suggests the instant set of compounds. Nor would it have been obvious to one of ordinary skill in the art at the time of the invention to modify the set of compounds of the prior art in order to arrive at that of the instant invention. There is no motivation to do so.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 571-272-0638. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne (Bonnie) Eyler can be reached at 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

 **BRIAN DAVIS**
PRIMARY EXAMINER
Brian J. Davis
November 21, 2007